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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,182	03/31/2004	Connie Marchek	DEP5291	7090
27777	7590	02/23/2006	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			REIMERS, ANNETTE R	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/815,182	Applicant(s) MARCHEK ET AL.	
	Examiner Annette R. Reimers	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on telephone election/restriction of 02/13/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 17-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16 and 23-33, drawn to a retractor blade assembly, classified in class 600, subclass 220.
- II. Claims 17-22, drawn to an instrument for adjusting an adjustable blade of a retractor blade assembly, classified in class 600, subclass 221.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed, because the instrument does not require a retractor blade assembly comprising a fixed blade having a longitudinal axis and an adjustable blade operatively coupled to the fixed blade and adjustable relative to the fixed blade along the longitudinal axis of the fixed blade, the adjustable blade including a flexible tab formed from the adjustable blade and having a distal end coupled to the adjustable blade, a proximal end of the flexible tab being pivotable about the distal end between a first position, in which the tab is generally co-planar to the adjustable blade, to a second position, in which the tab is oriented generally transverse to the adjustable blade, the flexible tab being biased to the first position and having a projection

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engageable with one or more longitudinally aligned stops provided on the fixed blade, and the projection engaging a stop when the tab is the first position to fix the adjustable blade relative to the fixed blade. The subcombination has separate utility, such as a retractor blade assembly.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above, and the search required for Group I is not required for Group II, and vice versa, restriction for examination purposes as indicated is proper.

Election of Species

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species (Retractor Blade Assembly)

- I. Figures 1-7
- II. Figures 8A-9
- III. Figures 10-13
- IV. Figures 14-18
- V. Figures 23-24
- VI. Figures 25-29
- VII. Figure 30
- VIII. Figures 31-33

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with David Lane, applicant's representative, on Monday, February 13, 2006, a provisional election was made without traverse to prosecute Invention I, claims 1-16 and 23-33, and species I, Figures 1-7, with claims 1-8 and 10-16 reading on the elected species. Examiner agrees with applicant regarding all of the claims reading on the elected species, i.e. Figures 1-7. Affirmation of this election must be made by applicant in replying to this Office action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claims 9 and 17-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the telephone conversation on Monday, February 13, 2006.

Drawings

The drawings are objected to because some of the drawings appear to be informal and are difficult to understand, i.e. figures 25-33. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended."

If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by the Fiore (US Patent Number 3,815,585).

Fiore discloses a retractor blade assembly comprising a fixed blade, 15 having a longitudinal axis and an adjustable blade, 18, operatively coupled to the fixed blade and adjustable relative to the fixed blade along the longitudinal axis of the fixed blade, the adjustable blade includes a rectilinear flexible tab, 40, wherein the flexible tab is movable between a first position in which the tab is generally co-planar to the adjustable blade and a second position in which the tab is oriented generally transverse to the adjustable blade (see figure 1). The flexible tab is biased to the first position, and the flexible tab is configured to move away from the fixed blade when moved to the second position (see figure 1). In addition, a distal portion of the flexible tab is coupled to and

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formed from the adjustable blade, and the flexible tab is pivotable about the distal portion between the first and second positions (see figure 1). The flexible tab further includes a projection, 39, for engaging the fixed blade when the tab is in the first position (see figure 1). In addition, the fixed blade includes a plurality of teeth stops, 42, for receiving the projection (see figure 1).

The flexible tab also includes a proximally facing instrument engagement surface to facilitate adjustment of the adjustable blade relative to the fixed blade (see figure 1). The adjustable blade includes an opening adjacent the instrument engagement surface to facilitate positioning of an instrument against the instrument engagement surface (see figure 1). Furthermore, the opening is sized to receive the distal end of an instrument for adjustment of the adjustable blade relative to the fixed blade and the opening is positioned proximal to the instrument engagement surface (see figure 1). Moreover, the instrument engagement surface is oriented generally perpendicular to the longitudinal axis of the fixed blade (see figure 1).

Claims 1-8 and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by the Pestka et al. (US Patent Number 3,650,266).

Pestka et al. disclose a retractor blade assembly comprising a fixed blade, 12 having a longitudinal axis and an adjustable blade, 16, operatively coupled to the fixed blade and adjustable relative to the fixed blade along the longitudinal axis of the fixed blade, the adjustable blade includes a rectilinear flexible tab, 18b, wherein the flexible tab is movable between a first position in which the tab is generally co-planar to the adjustable blade and a second position in which the tab is oriented generally transverse

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to the adjustable blade (see figures 1 and 2). The flexible tab is biased to the first position, and the flexible tab is configured to move away from the fixed blade when moved to the second position (see figures 1 and 2). In addition, a distal portion of the flexible tab is coupled to and formed from the adjustable blade, and the flexible tab is pivotable about the distal portion between the first and second positions (see figures 1 and 2). The flexible tab further includes a projection, 18d, for engaging the fixed blade when the tab is in the first position (see figures 1 and 2). In addition, the fixed blade includes a plurality of teeth stops, 14e, for receiving the projection (see figures 1 and 2).

The flexible tab also includes a proximally facing instrument engagement surface to facilitate adjustment of the adjustable blade relative to the fixed blade (see figure 1). The adjustable blade includes an opening adjacent the instrument engagement surface to facilitate positioning of an instrument against the instrument engagement surface (see figure 1). Furthermore, the opening is sized to receive the distal end of an instrument for adjustment of the adjustable blade relative to the fixed blade and the opening is positioned proximal to the instrument engagement surface (see figure 1). Moreover, the instrument engagement surface is oriented generally perpendicular to the longitudinal axis of the fixed blade (see figure 1).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER